



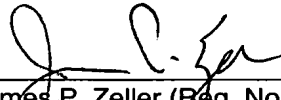
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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicants: Holger Bengs et al.)
Serial No.: 09/869,511)
Filed (I.A.): November 30, 1999)
Title: PREPARATIONS CONTAINING)
ALPHA POLYGLUCANS FOR)
TOPICAL APPLICATION)
Group Art Unit: 1617)
Examiner: Russell Travers)
Attorney Docket No.: 29988/AX98148)

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on April 2, 2003.


James P. Zeller (Reg. No. 28,491)
Attorney for Applicants

RESPONSE TO OFFICIAL ACTION
PURSUANT TO 37 C.F.R. § 1.143

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper is being presented pursuant to 37 C.F.R. § 1.143 and in response to an official action dated March 6, 2003, wherein pending claims 1-15 were subjected to a two-way restriction requirement. Specifically, the action alleges that claims 1-12, 14, and 15 (Group I) are drawn to a topical cosmetic composition containing various specific glucan compounds, whereas claim 13 (Group II) is drawn to linear poly- α -glucan compounds. The restriction requirement is respectfully traversed, and reconsideration and withdrawal of the restriction requirement are requested in view of the following remarks.

I. The Restriction Requirement Is Traversed

A. The Restriction

As bases for the restriction, the action states the following:

The above delineated inventions are independently and patentably distinct each from the other. The grouped inventions are a compound, useful for any purpose, and a composition of matter containing specific glucan compounds. These inventions differ as to their physical form and intended use, a reference which would anticipate the invention of one group would neither anticipate, nor make obvious the inventions in the other groups. The searches are not co-inclusive as indicated by the diverse classification of the subject matter. One skilled in the art would readily practice the invention of one of the above groups without infringing and or practicing the invention of another group. The subject matter is unique and has acquired a separate status in the art and is fully capable of supporting separate patents. For the foregoing reasons restriction is proper for examination purposes.

Official action at p. 2.

B. The Standard for Requiring Restriction Has Not Been Met

Because this application is the U.S. national phase of an international (PCT) application, unity of invention practice — not restriction practice — is applicable. See M.P.E.P. § 1893.03(d) (8th Ed., Rev. 1, Feb. 2003). Accordingly, the standard for issuing a lack of unity of invention rejection requires a showing by the U.S. Patent and Trademark Office ("USPTO") that (a) there are different groups of claims present in one application, and (b) why each of the groups lacks unity relative to each other group specifically describing the unique special technical feature in each group. *Id.* While the action has set forth two different groups of claims, it is respectfully submitted that the action provides neither an explanation as to why the claims of Group I lack unity relative to the claim of Group II (and vice versa) nor an explanation specifically describing the unique special technical feature in each group. Both explanations are required to support the lack of unity of invention rejection. *Id.*

Furthermore, if the USPTO is taking the position that the two groups of claims define separate inventions, then it is respectfully submitted that the applicants have a right to include both groups in this single application because they are so linked as to form a general inventive concept. A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature that defines the contribution which each claimed invention, when considered as a whole, makes over the prior art. The examiner's attention is directed to Example 15 of Annex B, Part 2 of the PCT Administrative Instructions as amended July 1, 1992, contained in Appendix A1 of the M.P.E.P. (copy of p. AI-70 attached) for an analogous description.

C. Admissions Concerning the Patentability of the Claims Result if the USPTO Maintains the Restriction Requirement¹

If the restriction requirement is maintained, then the USPTO admits that the Group I composition claims are patentable over a disclosure of the Group II compound claims, and vice versa. *See e.g.*, M.P.E.P. § 802.01 (8th Ed., Aug. 2001).

These admissions are necessary to entry of the restriction requirement by the USPTO and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions regarding patentability, then the restriction requirement should be withdrawn or reexamined under 35 U.S.C. § 121 pursuant to the provisions of 35 U.S.C. § 372(b)(2).²

Moreover, because restriction of the pending claims presents potential double patenting concerns, the requirement should be withdrawn. For example, 35 U.S.C. § 121 "prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a *heavy burden* on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention." *See* M.P.E.P. § 804.01 (emphasis added).

D. Search and Examination of the Entire Application Can Be Made Without Serious Burden on the Examiner

The restriction requirement is further traversed because there is no evidence that search and examination of the entire application would be a serious burden on the USPTO. The USPTO has not even alleged that there would be a serious burden on the USPTO.

¹ 35 U.S.C. § 372(a) provides that "all questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the cases of national applications regularly filed in the Patent and Trademark Office." Accordingly, the effects of restricting claims in the USPTO are the same whether the unity of invention standard of PCT Rule 13 or the independent and distinct inventions standard of 35 U.S.C. § 121 is applied as the basis for restriction.

² 35 U.S.C. § 372(b)(2) states that "the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of this treaty and the Regulations."

It is submitted that a complete search directed to the subject matter of the claims of Group I would require a search directed to the subject matter of the sole claim in Group II, and vice versa. Groups I and II are directed to similar subject matter — both groups recite linear poly-alpha-glucan compounds. Since search and examination of the entire application can be made without serious burden on the USPTO, it would be wasteful of the time, effort, and resources of both the applicants and the USPTO to prosecute claims directed to the compound and the composition containing the compound in separate applications.

In view of the foregoing, the applicants respectfully request that the restriction requirement be withdrawn. Additionally, if the restriction requirement is maintained, the applicants will likely incur additional prosecution costs associated with filing one or more divisional applications, and the USPTO will be required to perform duplicative searches. Thus, withdrawal of the restriction requirement will reduce the burden on the USPTO and on the applicants. For this additional reason, the imposed restriction requirement should be withdrawn.

II. Provisional Election

Pursuant to the requirements of 37 C.F.R. § 1.143, the applicants hereby elect the composition claims of Group I, i.e., claims 1-12, 14, and 15.

CONCLUSION


Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is urged to contact the undersigned attorney.

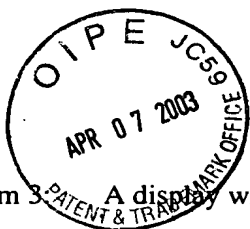
Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

April 2, 2003

By:


James P. Zeller (Reg. No. 28,491)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300 TELEPHONE



MANUAL OF PATENT EXAMINING PROCEDURE

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.

Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

Example 14

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Example 16

Claim 1: An insecticide composition comprising compound A (consisting of a_1, a_2, \dots) and a carrier.

Claim 2: Compound a_1 .

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a_1 has the insecticidal activity which is also the special technical feature for compound A in claim 1.

Example 17

Claim 1: Protein X

Claim 2: DNA sequence encoding protein X.